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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,605	03/29/2004	Harry Duke	1639.002US1	2859
21186 7590 02/15/2008 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 02/15/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/811,605

Applicant(s)

DUKE, HARRY

Examiner

Jeffrey D. Carlson

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: ____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3/29/04, 12/9/05, 5/25/06, 7/31/06, 5/15/07.

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- Claim 34 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim merely sets forth a bank card which, even if it stores data such as an account identifier, is not statutory subject matter. The card is taken to represent data per se. Further, there is no useful, concrete and tangible result or a physical transformation taking place. While much of the claim refers to a collection of features which are considered to be concrete, useful and tangible, these features are not capable of being performed by the card itself. Applicant should include all of the other components of the system in order to overcome this rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4, 18-32, 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 4, there is no antecedent basis for any bond fund.
- Claim 18, 26, it is not clear how a step of receiving can include all of the apparent related details. Is there a positive step of “using” the card, attempting a transaction, creating the accounts? As it stands, the claim appears to merely set forth a step of receiving, ensuring and settling. Applicant should clearly set forth the desired limitation.
- Claim 32 is a system (apparatus) claim, yet it include many features which are presented as method steps rather than capabilities, rendering the claim scope uncertain. In these computer-based system claims, the best way to set forth apparatus structure is to claim *capabilities* of the apparatus by stating an element/module/subsystem is *programmed to <perform an act>* OR is *configured to <perform an act>*, rather than claiming the element actively performs the act. A claim covering both an apparatus and a method of using that apparatus is invalid because such a claim “is not sufficiently precise to provide competitors with an accurate determination of the ‘metes and bounds’ of protection involved” and is “ambiguous.” MPEP 2173.05(p)(ii).
- Claim 32 sets forth an apparatus having an account database comprising a balance, yet applicant provides many features associated with the balance without any particular system structure capable of providing those features. For example, a stored balance of \$100 is merely the number 100 stored in memory; how the value 100 came to be or where the funds came from cannot be clearly set forth in a limitation concerning the ultimate balance itself.

- Claim 34, it is not clear how the card itself is capable of accomplishing all of the apparent features present in the claim. What programmed capabilities (i.e. structure) are present in the card such that the bulk of the claim language can be carried out.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 5, 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Carroll et al (US2002/0023026).**

6. Regarding claims 1, 5, 17, Carroll et al teaches that electronic gift certificates are deposited into a user's investment account and then transferred into pre-selected investment products (i.e. sub accounts) [abstract, 0009, 0007]. The investment account therefore has a calculated net value of the total of sums associated with each investment product (subaccount) [0019]. The investment account is taken read on a "gift card account" as this phrase merely requires an "account" and further that the purchased gift certificates can be taken to be electronic gift cards/vouchers.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-4, 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carroll et al.

9. Regarding claims 2-4, it would have been obvious to one of ordinary skill at the time of the invention to have chosen any well known investment product in a manner as taught by Carroll et al, including the known products claimed by applicant, so as to offer a wide variety of flexible investment strategies.

10. Regarding claim 6, it would have been obvious to one of ordinary skill at the time of the invention to have calculated a net asset value of the account as often as desired, including daily as is well known, so as to provide up to date portfolio values.

11. Regarding claims 7, 8, It would have been obvious to one of ordinary skill at the time of the invention to have enable the user to transfer funds between investment products (sub accounts) at the consumer's will, especially as Carroll et al teaches that the user's have control of their investment products chosen.

12. Regarding claims 9, 10, it would have been obvious to one of ordinary skill at the time of the invention to have held funds in a clearing account until the funds were available in a manner as is well known.

13. Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kang (KR2001000910) in view of Carroll et al.

14. Regarding claims 1, 5, 17-20, Kang (KR2001000910) teaches the purchase of a gift certificate for eventual use as payment for purchasing a product from a retailer, as is generally commonplace. Additionally however, Kang (KR2001000910) teaches that the gift certificate can include fluctuating interest and when funds from the gift certificate are redeemed for products, the value of the gift certificate can increase with time. Clearly Kang (KR2001000910) recognizes that the holder of the gift certificate account can benefit from the time-value of money. One of ordinary skill would recognize that there are additional ways to benefit from the time-value of money and would find it obvious to allow the funds of the gift certificate/card account to be invested in a wide variety of investment products. Further, Carroll et al teaches that electronic gift certificates are deposited into a user's investment account and then transferred into pre-selected investment products (i.e. sub accounts) [abstract, 0009, 0007]. The investment account therefore has a calculated net value of the total of sums associated with each investment product (subaccount) [0019]. It would have been obvious to one of ordinary skill at the time of the invention to have managed the obvious concept of investing gift certificate monies using the techniques of Carroll et al.

15. Regarding claims 2-4, 23-25, it would have been obvious to one of ordinary skill at the time of the invention to have chosen any well known investment product in a manner as taught by Carroll et al, including the known products claimed by applicant, so as to offer a wide variety of flexible investment strategies.

16. Regarding claims 6, 21, it would have been obvious to one of ordinary skill at the time of the invention to have calculated a net asset value of the account as often as desired, including daily as is well known, so as to provide up to date portfolio values.

17. Regarding claims 7, 8, 22, It would have been obvious to one of ordinary skill at the time of the invention to have enable the user to transfer funds between investment products (sub accounts) at the consumer's will, especially as Carroll et al teaches that the user's have control of their investment products chosen.

18. Regarding claims 9, 10, it would have been obvious to one of ordinary skill at the time of the invention to have held funds in a clearing account until the funds were available in a manner as is well known.

19. Regarding claims 11-16, 26-31, Official Notice is taken that there typically are eligibility rules/restriction associated with redeeming funds from a gift card/certificate account balance, such as a maximum amounts and restrictions to participating merchant/categories.

20. Regarding claims 32-35, Kang (KR2001000910) teaches that the verification is done over a computer network between the branch office and the POS. It would have been obvious to one of ordinary skill at the time of the invention to have used approved banking identifiers for the accounts of Carroll et al so that deposits, withdrawals and redemptions can occur in near real time over a network. Kang (KR2001000910) further teaches scanning of the gift certificate/card with is taken to read on swiping the card at the POS. Clearly Kang (KR2001000910) contemplates verifying requested purchase amounts against an up-to-date account balance whereby if the balance >> the purchase

amount, it is approved. Kang (KR2001000910) also is taken to deny redemptions where the balance is not sufficient; this also happens to read on the optionally claimed method step regarding "not a sufficiently large number". It would have been obvious to one of ordinary skill at the time of the invention to have updated user accounts after redemptions are made so as to appropriately reflect the diminished account balances.

Conclusion

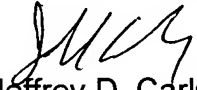
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:
10/811,605
Art Unit: 3622

Page 9

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc